

Appl. No. 09/656,258
Response Dated December 9, 2003
Reply to Office Action of September 11, 2003

REMARKS/ARGUMENTS

Responsive to the Office Action, Applicants respectfully request reconsideration for allowance of Claims 1, 2, 8 through 26 and 29 through 31 as presented herein for the cogent reasons set forth hereinbelow.

In the Office Action, the Examiner rejected Claims 1, 2, 8 through 26 and 29 through 31 under 35 U.S.C. 112 as failing to comply with the written description requirement. The Examiner has stated that the claims recite forming a substantially planar surface or indentation or window where the indentation depth is at least about equal to the thickness of the image sheet. Although independent Claims 1, 17 and 29 include recitation that a substantially planar indentation having a depth at least about equal to the thickness of the image sheet is formed as part of the method recited in these claims Applicants respectfully submit that independent Claims 30 and 31 do not include this limitation. However, Applicants verily believe the steps set forth in Claims 30 and 31 are clearly supported by the specification. The specification describes the subject matter of Claims 30 and 31 in such a way as to reasonably convey to one skilled in the art that Applicants, at the time the application was filed, had possession of the invention set forth in these claims.

Applicants also respectfully submit that the recitation in independent Claims 1, 17 and 29 regarding the indentation depth being at least about equal to the thickness of the image sheet is fully supported by the specification. These claims include subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicants, at the time the application was filed, had possession of the claimed invention. In this regard, Applicants respectfully submit that the specification describes on page 14, lines 15 through 17, that the depth of the debossing or indentation which creates the window 22 is preferably about

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equal to the thickness of the image sheet 18. Accordingly, Applicants submit that the specification clearly describes a method wherein the depth of the debossing which creates the indentation in the member to which the image sheet is applied is preferably at least as great as the thickness of the image sheet so as to recess the image sheet in the member to which it is applied as required by Claim 1, or that the image sheet is disposed in a planar window area having a depth at least about equal to the thickness of the image sheet as required by Claim 17, or the member to which the image sheet is applied is debossed to form a substantially planar indentation having a depth at least about equal to the thickness of the image sheet as required by Claim 29. Applicants respectfully traverse the rejection under 35 U.S.C. 112 and request that this rejection be withdrawn.

In the Office Action, the Examiner rejected Claims 1, 15 and 30 under 35 U.S.C. 103(a) as being unpatentable over the teaching of US Patent 4,981,386 to Beleckis in view of US Patent 5,441,589 to Groswith, III et al. and US Patent 4,160,685 to Kuroda. Applicants respectfully request reconsideration for allowance of Claim 1, the claims dependent thereon (including Claim 15) and independent Claim 30. The Beleckis reference describes a spring binder type notebook with a configuration of a cover which, when folded in a particular manner, forms an easel for supporting the notebook and the documents bound therein. Beleckis describes that the notebook cover may be formed of a rigid material such as rigid cardboard or plastic and typically overlaid with fabric or plastic film for appearance purposes. In no other respects is the Beleckis reference relevant to the method set forth in Claims 1 or 30 or the claims dependent on Claim 1. In regard to the teaching of the Groswith, III et al. reference, this patent describes a relatively complicated hot debossing stamper type printing machine for imprinting titles, authors names, logos and other

information on covers of books, or marketing, sales, engineering, research or business office booklets or reports. The Groswith, III et al. reference describes a machine which includes logo die and alpha numeric character dies which engage a foil tape to transfer material, such as ink, residing on the tape to a member, such as a paper stock report cover or the like. Accordingly, the Groswith, III et al. reference does not suggest the provision of an image sheet of a flexible material to be bonded to a member formed of flexible and indentable material, nor does Groswith, III et al. suggest placing an image sheet in contact with such a member and bonding the image sheet to the member and further debossing the member to form a planar indentation during the bonding process wherein the indentation has a depth at least as great as the thickness of the image sheet so as to recess the image sheet in the member. The Examiner states that Groswith, III et al. describes that a planar indentation is formed with a depth at least as great as the thickness of the tape, as set forth in column 10, lines 45 through 69 and as shown drawing Figure 26. Since drawing figures in patent applications cannot be scaled, there is no way to ascertain whether or not the "material" that is transferred to the report cover member is of a thickness about equal to the indentation in the cover member.

Applicants respectfully submit that there is no description in Groswith, III et al. including column 10, lines 45 through 59, that the debossing process in Groswith, III et al. forms a planar indentation having a depth at least as great as the thickness of an image sheet. Groswith, III et al. does not disclose or suggest the provision of an image sheet nor that the embossment die for the print or the character wheel of Groswith, III et al. forms a planar indentation or an indentation having a depth at least as great as the thickness of the image sheet. Accordingly, the teaching of Beleckis and Groswith, III et al. clearly does not suggest an important

aspect of the invention. Applicants respectfully submit that the further teaching of Kuroda does not provide for an important requirement of Claims 1 and 30 as described above regarding the thickness of the image sheet with respect to the depth of indentation. As previously pointed out, in the prosecution of this application the appliqué of Kuroda is formed by providing a die which engages layered material, includes cutting edges to sever the layers along an outer contour line and compresses a foam plastic layer to form a three dimensional appliqué and to provide a cushion between the outer layer or image sheet and a base layer of the structure of Kuroda. Accordingly, an important element of Claims 1 and 30 is completely missing from the teaching of the references and reconsideration for allowance of these independent claims is respectfully requested.

Claim 15 remains dependent on Claim 1 and reconsideration for allowance of this claim at least for the reasons set forth above in support of the patentability of Claim 1 is also requested.

In the Office Action, the Examiner rejected Claims 2, 8 through 10 and 13 under 35 U.S.C. 103(a) as being unpatentable over the teaching of Beleckis in view of Groswith, III et al. and Kuroda and further in view of US Patent 5,380,044 to Aitkens et al. Claims 2, 8 through 10 and 13 remain in the application dependent on Claim 1 and are believed to be patentable at least for the reasons set forth above in support of the patentability of Claim 1. The lack of teaching of the overall combination of features set forth in Claims 2, 8 through 10 and 13 with respect to the Beleckis, Groswith, III et al. and Kuroda references is set forth hereinabove. The Aitkens et al. reference describes a method of printing desired information in reverse on a transparent vinyl sheet which is then fused to a plastic substrate to seal the printed ink between the vinyl and the plastic substrate and allow the ink to leach into and permanently mark the substrate. Accordingly, the further

teaching of Aitkens et al. does not suggest or make obvious the overall combination of features set forth in Claim 2 which requires cutting the image sheet from a larger sheet of the same material as the image sheet prior to placing the image sheet in contact with the flexible and indentable member. One of the advantages of the combination of elements and steps set forth in the claims in this application is a simplified and economical process for applying indicia to business articles by providing the image sheet and application process as set forth in Claim 1 and the claims dependent thereon. The use of complex printing machines is avoided as suggested by Groswith, III et al., for example. Moreover, in seeking an improved process for making business articles, Applicants respectfully submit one would not look to the teaching of the art of making identification cards to improve a process which includes the steps of printing images on an image sheet which is part of a larger sheet required by Claim 8, providing the images from an image source by scanning or copying the image and transferring the image to a printing apparatus, as required by Claim 9, or applying an ink receptive coating on the image sheet prior to printing the image thereon, as required by Claim 10 or printing multiple images on a larger sheet and cutting multiple image sheets from the larger sheet as required by Claim 13. Thus, the overall combinations of steps set forth in Claims 2, 8 through 10 and 13 is clearly not suggested or made obvious by the prior art. Reconsideration for allowance of Claims 2, 8 through 10 and 13 is also respectfully requested.

In the Office Action, the Examiner rejected Claim 11 under 35 U.S.C. 103(a) as being unpatentable over the teaching of the combination of references set forth above in rejecting Claims 2, 8 through 10 and 13 and further in view of US Patent 5,891,552 to Lu et al. The provision of a textured surface on the image sheet as required by Claim 11 and where the image sheet is disposed in a recess or indentation having a thickness at least

as great as the thickness of the image sheet is an important consideration in high wear rate articles of the type set forth in Claims 1, 10 and 11. Neither Lu et al. nor the other references suggest, taken alone or one modified in view of the other, the overall combination of steps and features of Claim 11 and reconsideration for allowance of this claim is also requested.

The Examiner rejected Claims 12, 14 and 16 under 35 U.S.C. 103(a) over the teaching of Beleckis in view of Groswith, III et al., Kuroda, Aitkens et al. and further in view of US Patent 5,974,230 to Jenkins. Although Claims 12, 14 and 16 provide the steps of laminating a transparent laminate sheet onto the image sheet over the image, laminating a transparent laminate sheet to the larger sheet over plural images on the larger sheet, providing the laminate sheet of polyvinylchloride as set forth and in Claims 12, 14 and 16, respectively, Applicants also respectfully submit that the further teaching of a label generating technique and apparatus for making file folder labels, as described in the Jenkins '230 reference would not make obvious to one of ordinary skill in the art of making articles comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or key fob all of the steps set forth in Claims 1 and 12, or Claims 1, 2, 13 and 14, or Claims 1, 2, 13, 14, 15 and 16 and reconsideration for allowance of Claims 12, 14 and 16 is also requested.

In the Office Action, the Examiner rejected Claims 17, 19, 24 through 26 and 31 under 35 U.S.C. 103(a) as being unpatentable over the teaching of Beleckis in view of Groswith, III et al., Kuroda and Aitkens et al. With regard to Claim 17 and the claims dependent thereon, Applicants further respectfully submit that none of the references cited in rejecting Claim 17 taken alone or in combination disclose or suggest the steps of providing a member of a flexible and indentable material, providing an image sheet which is cut from

a larger sheet of flexible material which has an image transferred thereto by way of a processor which controls a printer for printing multiple images on the larger sheet, and further including the steps of placing at least one of the image sheets in contact with the member formed of flexible and indentable material and then bonding the image sheet to that member by engaging the image sheet with a debossing die, applying RF energy to bond the image sheet to the member at a planar indentation formed in the member and whereby the image sheet is disposed in a debossed planar window area formed in the member having a depth at least about equal to the thickness of the image sheet, as required by Claim 17. As pointed out hereinabove with respect to the teaching of Beleckis, Groswith, III et al., Kuroda and Aitkens et al., none of these references suggest the overall combination of steps set forth in Claim 17, including the step of disposing the image sheet in a debossed planar window area having a depth at least about equal to the thickness of the image sheet. Reconsideration for allowance of Claim 17, together with Claims 19, and 24 through 26 is therefore respectfully requested.

With regard to Claim 31, as pointed out hereinabove, this claim does not include the requirement of an indentation or window having a depth at least as great as the thickness of an image sheet. However, Claim 31 does set forth a patentably distinct method which is not believed to be made obvious by the teaching of the references. The overall combination of steps of providing a sheet of flexible plastic material receptive to multiple printed images on one side, transferring an image to be applied to the sheet to a processor, causing the processor to control a printer for printing multiple images on the sheet of flexible plastic material, cutting multiple image sheets from the sheet of flexible plastic material along predetermined contours, placing at least one of the image sheets in contact with a substantially planar surface of the member, bonding the

image sheet to the member with a substantially planar die and applying RF energy to bond the image sheet to the member clearly is not suggested or made obvious to one of ordinary skill in the art by the combination of references cited by the Examiner in rejecting Claim 31. The steps set forth in Claim 31 are not suggested in Beleckis. The complex printing machine of Groswith, III et al. does not utilize image sheets which are provided by cutting multiple ones of such image sheets from a sheet of material which had multiple images formed thereon and controlled by a processor as required by Claim 17. Aitkens et al. does not suggest such a process. Kuroda does not suggest such a process and, moreover, suggests a method of making an appliqué type article having three dimensional characteristics, Kuroda does not use a planar die, and does not provide a substantially planar image presented on a substrate or receiving member. Accordingly, reconsideration for allowance of Claim 31 is respectfully requested.

In the Office Action, the Examiner rejected Claims 18 and 20 under 35 U.S.C. 103(a) as being unpatentable over the teaching of Beleckis, in view of Groswith, III et al., Kuroda, Aitkens et al. and further in view of US Patent 5,817,205 to Kaule. Claims 18 and 20 depend from Claim 17 and are believed to be patentable at least for the reasons set forth above in support of the patentability of Claim 17. As mentioned previously, the Kaule reference, which is from a somewhat diverse art and unrelated to the manufacture of articles such as portfolios or desk folders, suggests providing smooth and finished surfaces on documents for application of a bonding agent followed by transfer of an endless hologram to a glazed stripe or stripes formed on the document surface. The Kaule reference certainly does not suggest the overall combination of steps of Claim 17, in combination with the steps of Claims 18 or 20, respectively. The requirements of Claim 17 regarding the depth of indentation together with the step of debossing the

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member to form the indentation to provide a guide for locating the image sheet, as required by Claim 18, is not suggested or made obvious by the references. Moreover, with regard to Claim 20, the combination of references does not suggest the overall combination of steps of Claims 17 and 20 including locating a guide device for guiding the placement of the image sheet on the member and placing the image sheet on the member in a predetermined position as provided by the guide device prior to forming an indentation comprising a debossed planar window which has a depth at least equal to the thickness of the image sheet. Reconsideration for allowance of Claims 18 and 20 is respectfully requested.

Reconsideration for allowance of Claim 21 is requested. This claim was rejected under 35 U.S.C. 103(a) as being unpatentable over the teaching of Beleckis, in view of Groswith, III et al., Kuroda and Aitkens et al. and further in view of US Patent 2,602,560 to Pargh. Taking into consideration the reasons in support of the patentability of Claims 18 and 20 the further teaching of Pargh with regard to providing light beams for identifying the location of the application of labels does not suggest the overall combination of features of Claims 17 and 21. Reconsideration for allowance of this claim is also requested.

Applicants request reconsideration for allowance of Claims 22 and 23 which were rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis in view of Groswith, III et al., Kuroda and Aitkens et al. and further in view of Jenkins '230. Claims 22 and 23 depend from Claim 17. As pointed out hereinbefore with respect to Claims 12, 14 and 16, the overall combination of steps set forth in Claims 17, 22 and 23, which include lamination steps, and the provision of the sheet of flexible plastic material, as well as the transparent sheet of polyvinylchloride, bonding an image sheet by a process which includes the formation of a planar indentation forming a

debossed planar window area having a depth at least about equal to the thickness of the image sheet (as required by Claim 17) is not disclosed or suggested by this combination of references. Reconsideration for allowance of Claims 22 and 23 is also requested.

Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over the teaching of Beleckis in view of Groswith, III et al., Kuroda and Kaule. As pointed out hereinabove with respect to the lack of teaching of Beleckis, Groswith, III et al. and Kuroda, in support of the patentability of Claim 1, these references fail to suggest debossing a member to receive an image sheet to form a substantially planar indentation having a depth at least about equal to the thickness of the image sheet. Claim 29 requires such a debossing step. The references fail to disclose, suggest or make obvious such a step together with the other steps recited in Claim 29, and the steps set forth in the claim are not made obvious by the additional teaching of Kaule. The glazing application steps in Kaule to provide a hologram for banknotes and the like do not suggest to one of ordinary skill in the art of making business accessory articles with printed images thereon, the overall combination of steps set forth in this claim and reconsideration for allowance of Claim 29 is also respectfully requested.

Applicants have made a further diligent effort to advance the prosecution of this application by pointing out herein how the claims currently presented are supported by the specification in a way to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed and that the claims now presented conform to the requirements of 35 U.S.C. 112. Applicants have further pointed out with particularity how the claims now presented distinguish in a patentable sense over the prior art of record. Reconsideration for allowance of

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Claims 1, 2, 8 through 26 and 29 through 31 is respectfully
requested.

Respectfully submitted,

Date: 12/09/03

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